APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,479	01/28/2004	Mikko K. Makela	037145-1101	5071

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Applicant's remarks (dated 1/11/2008 on page 2) correctly point out that in the

Office action (dated 10/18/2007, no new rejections were made against claim 8 or 12.

Applicant is further correct that in the Office action dated 10/18/2007, claims 8 and 12

stood rejected under 35 U.S.C. § 102(b) in view of Vale. Applicant is further correct in

that claims 8 and 12 were no longer Objected to for typographical errors.

Applicant remarks (dated 1/11/2008 on page 2):

> Applicant amended each of the independent claims to describe how
> the determining of whether a file was previously selected from a
> file list occurs in response to an accessing of the file list.
> However, the Examiner failed to consider this language in any of
> these rejections.

In response, the Examiner directs Applicant to paragraph 8 of the 10/18/2007

Office Action. In this paragraph, Applicant's arguments addressing the new language

are addressed. In paragraph 8, Applicant was quoted characterizing the prior art to

teach in "response to an accessing." Therefore Applicant's assertion, that the examiner

failed to consider this language in any of these rejections, is factually incorrect.

Applicant remarks (dated 1/11/2008 on page 2):

> However, the Examiner failed to consider this language in any of
> these rejections. Instead, the Examiner simply copied and pasted
> his arguments relating to Vale from the previous May 1, 2007
> Office Action, without making any comments regarding the phase 'in
> response to an accessing of the file list.'

In response, the Examiner directs Applicant to fact that numbered paragraph 8

(pp. 9-10) of the 10/18/2007 Office Action appeared for the first time in the 10/18/2007

Office Action. The heading *Response to Arguments* appeared for the first time in the

10/18/2007 Office Action. Therefore Applicant's assertion in this regard, is factually

incorrect.

Applicant remarks (dated 1/11/2008 on page 3):

> However, Applicant never asserted that the claims of the present
> application relied on the use of the direction key. Rather,
> Applicant was saying that the prior art used such a key as the
> trigger for the "determining" process, and this use was completely
> different from what is described in the claims. This point was
> made clearly by Applicant on page 11 of its previous response,
> where it noted that "[i]n other words, Vale clearly describes a
> system where any determining and selection of a "next" item in a
> list occurs in response to an action other than simply accessing
> the list." However, this point was simply ignored by the Examiner.
> Therefore, the Examiner's "response" to Applicant's argument
> regarding this point and others both mischaracterizes Applicant's
> arguments and, at the same time, fails to address these arguments
> in any substantive form.

In response, the Examiner directs Applicant to fact that arguing that the cited

prior art reference teaches additional features or unrelated embodiments, does nothing

to address the evidence relied upon in support of the rejection. For example, Applicant

stated that selection, "...occurs in response to an action other than simply accessing the

list." However, Applicant simply ignores that "*simply* accessing the list" is not recited in

the claims. Instead, all that is required is "an accessing". That is, the claims only

require what they express.

Now addressing the argument, as quoted above, that "Applicant never asserted

that the claims of the present application relied on the use of the direction key." First,

the claims are not limited so as to exclude the use of a *direction key* for accessing.

Second, the Claims are interpreted in light of a Specification that at para [0025] states,

"icons, menus, lists, etc. which the user can select by manipulating the user input

controls 14." (Emphasis added). Fig. 1 of Applicant Specification appears below:

FIG. 1
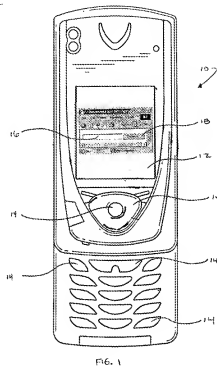
As can be seen element 14 appears to be a directional key. Therefore the

broadest reasonable interpretation of the claims that consistent with the specification,

permits a directional key for accessing of a file list. All actions heretofore have

addressed this issue and Applicant's argument does nothing to address the evidence

relied upon in support of the Rejection.

Applicant remarks (dated 1/11/2008 on page 4):

> Lastly, Applicant acknowledges that the Examiner did respond to
> Applicant's argument concerning claims 19, 27 and 46 of the
> pending application. However, the Examiner's arguments as to these
> claims are not correct....paragraph [0045] only mentions that the
> elements cited by the Examiner can be selected, which one skilled
> in the art would recognize is not the same as being saved.

The Examiner disagrees that one skilled in the art would fail to recognize that

the traversal index in para. [0045] was stored. Especially in view of the fact that the

logic of the software modules is taught to saved on a hard disk "...program modules

may be stored on the hard disk 39" (para. [0033]).Therefore, Applicant's assertion is factually incorrect and unsupported by any evidence of record.

Applicant remarks (dated 1/11/2008 on page 4) by way of footnote: "In fact, Applicant notes that the terms 'save' or 'saved' never appear anywhere in Vale" In response, the Examiner reminds Applicant that anticipation under 35 U.S.C. 102 occurs when each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis test*, i.e., identity of terminology is not required.[1] Vale taught:

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[1] *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

"In a networked environment, program modules depicted relative to the computer 20, or portions thereof, may be stored in the remote memory storage device. (para. [0035]);

"Program code means comprising one or more program modules may be stored on the hard disk 39, magnetic disk 29, optical disk 31, ROM 24 or RAM 25, including an operating system 35, one or more application programs 36, other program modules 37, and program data 38." (para. [0033]);

"A basic input/output system (BIOS) 26, containing the basic routines that help transfer information between elements within the computer 20, such as during start-up, may be stored in ROM 24. " (para. [0031]);

"By way of example, and not limitation, such computer-readable media may comprise RAM, ROM, EEPROM, flash memory, CD-ROM or other optical disk storage, magnetic disk storage or other magnetic storage devices, or any other medium which can be used to carry or store desired program code means in the form of computer-executable instructions or data structures and which can be accessed by a general purpose or special purpose computer. (para. [0028]);

When information is transferred or provided over a network or another communications connection (either hardwired, wireless, or a combination of hardwired or wireless) to a computer, the computer properly views the connection as a computer-readable medium. (para. [0028]); "Thus, any such a connection is properly termed a computer-readable medium. (para. [0028]);

Combinations of the above should also be included within the scope of computer-readable media. (para. [0028]);

Computer-executable instructions comprise, for example, instructions and data which cause a general purpose computer, special purpose computer, or special purpose processing device to perform a certain function or group of functions. (para. [0028]); and finally;

Computer-executable instructions, associated data structures, and program modules represent examples of the program code means for executing steps of the methods disclosed herein. (para. [0029]) (emphasis added).

Therefore, Applicant's assertion, although correct, is inapposite in view of the foregoing teachings.

Applicant remarks (dated 1/11/2008 on page 4):

> Second, Applicant disputes the notion that the elements cited by
> the Examiner constitute index numbers. Instead, these names are
> nothing more then designations that are used to select the file at
> issue, and it is the elements, not index numbers for the elements,
> which are selected.

The Examiner disagrees with Applicants interpretation of the cited reference.

Vale explicates that it is the input, that is being constrained by the predetermined and

stored traversal index order, not that the user is arbitrarily defining the traversal at

their freewill ("down direction *input* selects interactive elements in the *following*

order:...," para. [0033]). Otherwise the same direct key command, repeated, would take

an arbitrary path of, for example, its direction. However, it does not, instead the

selection path take on according to the stored traversal index order (e.g. Element 1,

Element 4, Element 6, Element 7. Beginning with Element 7, up direction input selects

interactive elements in reverse ord sertion in this regard, is factually incorrect in that it

mischaracterizes how the reference would be understood by one of ordinary skill in

Graphical User Interface Browsers, at the time of applicants invention.

Applicant remarks (dated 1/11/2008 on page 4):

> [t]hese names are nothing more then designations that are used to
> select the file at issue, and it is the elements, not index
> numbers for the elements, which are selected.

If the name were indeed nothing more then designations, then why are they

traversed in a numerical specified order? It is because the numerical order is the

traversal index. By arguing that the ordered index is nothing more than a designation,

Applicant fails to address why the index is not designated. Applicant has not

distinguished their invention, as claimed, from the cited reference but instead has

distinguished between various terminology used to describe the same thing.

	Application No.	Applicant(s)
Advisory Action **Before the Filing of an Appeal Brief**	10/767,479	MAKELA, MIKKO K.
	Examiner	Art Unit
	Samir Termanini	2178

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires _3 months_ from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See reasons starting on page 2.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.

13. ☐ Other: _____.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit 2178

/S. T./
Examiner, Art Unit 2178